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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,093	05/24/2001	Eddy Daelmans	501139	2724

23626 7590 03/27/2003

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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 03/27/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

178

Office Action Summary	Application No.	Applicant(s)	
	09/807,093	DAELMANS ET AL.	
	Examiner	Art Unit	
	Tamra L. Dicus	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. Some of the 112 rejections over multiple issues within claims 5-18 have been withdrawn. The 102(e) rejection to Cosentino et al. and Marbler et al. are withdrawn.

Claim Objections

2. Claim 9 is objected to under 37 CFR 1.75(c) as being in improper form because claim 9 depends on claims which are also multiple dependent See MPEP § 608.01(n).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Regarding claim 5, the term “the dry type” renders the claim(s) indefinite because the claims include elements not actually disclosed (those encompassed by “type”), thereby rendering the scope of the claims unascertainable. See *Ex parte Copenhaver*, 109 USPQ 118 (Bd. App. 1955).
7. In claim 10, the phrase “intended to be closed” is indefinite as it lends no positive recitation to the claim. It is not definite as to whether the sheets are closed.

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8. The phrase “when there is mutual contact” adds no positive recitation to the claim and is therefore indefinite.
9. Regarding claim 10, the phrase “such as” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
10. The phrases “adapted to be stored by rolling” and “adapted to be cut/closed” are indefinite, as the phrases do not state how it is adapted, or what this involves. Further the phrase is a process limitation, which is not considered in a product claim.
11. In claim 11, the term “a majority” is relative and therefore indefinite.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

13. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

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14. Claims 7 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 3,055,576 to Ottinger et al.

Ottinger teaches a wrapping material that is wound, comprising a web, where a water proof stripe (strip) of self-sealing latex adhesive on two outer edges of the web, which does not adhere to a surface when pressed against another surface such as in the wound roll. See col. 1, lines 20-31, col. 2, lines 1-35, col. 3, lines 5-28, and Figures 1-5. Ottinger explains at col. 3, line 26 that such a wrapping may be suitable for other materials besides carpet to wrap elongated objects. Ottinger shows a traverse edge in Figure 1 and at col. 2, lines 24-25 and 60-65. In regards to the strength of the adhesive e.g. “strong enough...but not strong enough...”, Ottinger explains the adhesive is pressed against the margins of the web adhered to one another, but not to a surface which doesn’t have the adhesive at col. 2, lines 5-17, which avoids the roll sticking together. Since the adhesive is in a roll and it doesn’t stick to the roll, this explanation is functionally equivalent to the description of the strength of the adhesive Applicant claims.

That the roll is “adapted to be stored/cut/closed” is of no consequence. The phrase “adapted to be cut/stored/closed” is indefinite, as the phrase does not state how it is adapted, or what this involves. Further the phrase is a process limitation, which is not considered in a product claim.

15. “When transversely/arranged/folded...” is of no consequence. Patentability to a product depends upon the product itself, not time limits of a procedure. Process limitations DO NOT change the product. See MPEP 2113.

Regarding claim 7, the following phrase is a process limitation:

- “...is spread out in the form of an egg-shaped strip”.

Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

14. Claims 5-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 92/19508 to Jones et al.

Jones teaches a wrapping for food comprised of a web with a cold-seal strips of adhesive on transverse cut edges wound in a roll. The web has an inner face, outer face, longitudinal edges, and traverse edges, with inner and outer cold-seal strips on the web. The paper has a non-stick, release coating of silicon at page 8, lines 19-23. See patented claim 14, abstract, Figures 4, 7, and 8, page 7, lines 9-28, page 8, lines 19-26, page 6, lines 10-25.

Regarding claim 5, that the packaging is “arranged to be at least partially superposed, once the sheet has been folded...” is immaterial. There is no

That the roll is “adapted to be stored/cut/closed” is of no consequence. The phrase “adapted to be cut/stored/closed” is indefinite, as the phrase does not state how it is adapted, or what this involves. Further the phrase is a process limitation, which is not considered in a product claim.

Jones does not teach “when arranged in mutual superposition...”. However, this is a process limitation in a product claim. Process limitations do not change the product. See MPEP 2113.

Regarding claims 5-18, the following phrases are process limitations:

- “...once the sheet has been folded” in claim 5

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- "...is deposited at least partially" in claim 6
- "...is spread out in the form of an egg-shaped strip" in claim 7
- "...is preapplied before the sealing coating" in claim 8
- "...is coextruded in the substrate of the sheet" in claim 9
- "...once the sheet has been folded around the article..." in claim 11
- "...arranged at least partially..." in claim 11
- "...holding the folds in place around the said article" in claim 11
- "...is spread out in the form of an oval strip" in claim 12
- "...is pre-applied under the sealing coating..." in claim 13
- "...is spread out..." in claims 14-18

Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F. 2d 531.

Regarding claims 7-9, how the cold sealing coating strips are processed, e.g. "is spread out...", "is preapplied...", "is coextruded...", are process limitations in a product claim. Process limitations DO NOT change the product. See MPEP 2113.

Response to Arguments

Applicant's arguments filed 1-13-03 have been fully considered but they are not persuasive. Applicant believes "dry type" is not indefinite as he believes its well known in the

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art. In response to the phrase “dry type” language of claim 5, “type” is indefinite since “type” includes elements not actually disclosed.

Applicant believes future tense phrases such as “adapted to be stored/cut/closed”, “when there is mutual contact”. In response to claim 10 the phrase “adapted to be closed” only involves that the article may be closed, not that it necessarily is closed. Hence “adapted to be stored/cut/closed” is indefinite, as the phrase does not state how it is adapted, or what this involves.

Applicant changed “most” to “a majority” in claim 11. However, “a majority” is still indefinite as this is a relative term and the specification does not provide a standard for ascertaining the requisite degree.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-8329 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Tamra L. Dicus
Examiner
Art Unit 1774

March 20, 2003

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

